

From: [Trials](#)
To: [Deborah Sterling](#); [Gary J Speier](#); [Trials](#)
Cc: [David H. Holman](#); [Tyler Liu](#); [Peter M Kohlhepp](#); [Nate D Louwagie](#); [PTAB Account](#); [PTAB Account](#)
Subject: IPR2024-00834 (U.S. Patent No. 11,590,088) – Petitioner's request to file Reply to Patent Owner's Preliminary Response
Date: Thursday, September 12, 2024 2:24:00 PM
Attachments: [image001.png](#)

Counsel,

From the Board –

Petitioner's request for authorization to file a Reply to Patent Owner's Preliminary Response is granted in part.

Petitioner's request for authorization to file a Reply addressing Patent Owner's arguments regarding § 314 and § 325(d) is granted. Having considered the parties' respective positions as reflected in the email string below, and based on our present review of the Petition and Preliminary Response, we find good cause exists to allow limited additional briefing as to these topics. Patent Owner devotes more than 20 pages arguing for discretionary denial under § 314 and § 325(d) (Paper 6 at 6–31). Petitioner does touch on § 325(d) discretion issues briefly (Paper 1 at 71–73), but we conclude on this record that the panel may benefit from hearing further from Petitioner on these discretionary issues, explaining why trial should be instituted notwithstanding Patent Owner's extensive argument.

Petitioner's request for authorization to file a Reply addressing Patent Owner's arguments in the Preliminary Response regarding "Sonti reference's anticipatory disclosures" is denied. The panel is not convinced Petitioner established good cause to reply to these arguments at this time. Petitioner alleges that good cause exists "to address certain omissions and mischaracterizations of the record and misapplication of Board cases." However, the panel is well situated to evaluate Patent Owner's characterization of the record and application of Board cases.

The Reply shall be limited to 5 pages and shall be filed no later than seven calendar days from the date of this e-mail. Patent Owner is authorized to file a 5-page Sur-Reply, limited to the same topics, no later than seven calendar days after the filing of the Reply.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Deborah Sterling <DSTERLING@sternekessler.com>
Sent: Thursday, September 5, 2024 5:58 PM
To: Gary J Speier <GSpeier@carlsoncaspers.com>; Trials <Trials@USPTO.GOV>
Cc: David H. Holman <DHOLMAN@sternekessler.com>; Tyler Liu <TLIU@sternekessler.com>; Peter M Kohlhepp <PKohlhepp@carlsoncaspers.com>; Nate D Louwagie <NLouwagie@carlsoncaspers.com>; PTAB Account <PTAB@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>
Subject: RE: IPR2024-00834 (U.S. Patent No. 11,590,088)

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Dear Honorable Board,

In response to Petitioner's request below, Patent Owner provides the following context that was omitted from Petitioner's email. Patent Owner did not simply oppose Petitioner's request with no explanation. Rather, Patent Owner explained to Petitioner that Patent Owner opposes Petitioner's request because the issues raised by Petitioner are not the types of issues that give rise to good cause for additional briefing in reply to the Patent Owner Preliminary Response.

Should the Board believe a conference call with the parties is necessary, counsel for Patent Owner is available at the times provided below.

Respectfully,
Deborah Sterling

Deborah Sterling, Ph.D. (she/her)
Director
Sterne, Kessler, Goldstein & Fox P.L.L.C.
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From: Gary J Speier <GSpeier@carlsoncaspers.com>
Sent: Thursday, September 5, 2024 4:06 PM
To: Trials@USPTO.GOV
Cc: Deborah Sterling <DSTERLING@sternekessler.com>; David H. Holman <DHOLMAN@sternekessler.com>; Tyler Liu <TLIU@sternekessler.com>; Peter M Kohlhepp <PKohlhepp@carlsoncaspers.com>; Nate D Louwagie <NLouwagie@carlsoncaspers.com>; PTAB Account <PTAB@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>
Subject: IPR2024-00834 (U.S. Patent No. 11,590,088)

EXTERNAL EMAIL: Use caution before clicking links or attachments.

Dear Board,

Petitioner respectfully requests leave to file an eight-page reply to Patent Owner's Preliminary Response in the above-referenced proceeding, to address Patent Owner's arguments regarding Section 325(d), the Board's discretion under Section 314, and the Sonti reference's anticipatory disclosures. In particular, Petitioner seeks to address Patent Owner's arguments that the Board should deny institution because the Sonti and Bissonnette references were cited on the face of the patent (though not discussed) and because Petitioner purportedly did not identify evidence that the Chen references disclosed administering tapinarof, as well as Patent Owner's characterization of the Examiner's reasons for allowance; the Patent Owner's arguments that the identification of the challenges, the Petition's word count, and citations to expert testimony allegedly did not comply

with Patent Office rules; and the Patent Owner's argument Sonti purportedly does not disclose a limited number of options for treatment. Good cause exists to file this reply to address certain omissions and mischaracterizations of the record and misapplication of Board cases, as well as because Patent Owner is arguing that Section 325(d) and Section 314 should be dispositive.

Petitioner emailed counsel for Patent Owner regarding these requests on August 30, 2024, and the parties met and conferred again on September 4, 2024. On September 5, 2024, Patent Owner informed Petitioner that it opposes these requests. Patent Owner also stated that if the Board grants Petitioner's request in whole or in part, Patent Owner will request authorization for a sur-reply of equal length. If Petitioner is authorized to file a preliminary reply, Petitioner does not oppose a Patent Owner preliminary sur-reply of equal length.

Should the Board believe a call is necessary to discuss Petitioner's requests, the parties are available on Monday (9/16) between 9am-1pm ET and 4pm-5pm ET, and Tuesday (9/17) between 2pm-5pm ET. These are the earliest dates of availability for the parties, as counsel for Patent Owner is not available the week of 9/9-9/13 due to planned international business travel, and counsel for Petitioner is not available on 9/6 due to planned international business travel.

Best regards,
Gary Speier

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